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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,659	09/29/2003	Michael Gomer Stelljes JR.	9372	2454

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EXAMINER

LONEY, DONALD J

ART UNIT PAPER NUMBER

1772

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,659

Applicant(s)

STELLJES ET AL.

Examiner

Donald Loney

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 10-23,25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Art Unit: 1772

DETAILED ACTION


1. In view of the Appeal Brief filed on February 21, 2006 and May 19, 2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:


Terrel Morris.
SPE 1771

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

Art Unit: 1772

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-9 and 24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 and 24 of copending Application No. 10/950706. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both recite non-adhesively bonded embossed sites and adhesively bonded non-embossed sites.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-9 and 24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 11/225946. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both recite non-adhesively bonded embossed sites and the other bond site can be considered the adhesively bonded non-embossed sites. The examiner notes application 11/225946 is a division of the instant application, however, the claims have been amended and the instant claims would be subject to a double patenting rejection as indicated above due to said amendment.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Donnelly (3708366) as presented in the office action, dated November 3, 2005.

Donnelly discloses an embossed multiply sheet wherein the first face comprises non-adhesively bonded embossed sites (top protrusion section just to the right of 9' which can be considered the top of the embossment) and adhesively bonded non-embossed sites at 13 (i.e. a valley portion). Refer to figure 3, which is substantially the same as applicant's figure 1A. Refer to column 3, line 70 through column 4, line 2 disclosing that the embossed sites are non-adhesively bonded, even if it is quite low for normal moisture content webs and more adhesion is provided if the moisture content is about 20%. Also refer to column 3, line 26 through column 4, line 36.

Claim Rejections - 35 USC § 103

Art Unit: 1772

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donnelly in view of Ruppel et al (5846636).

Donnelly discloses an embossed multiply sheet wherein the first face comprises non-adhesively bonded embossed sites (top protrusion section just to the right of 9'

Art Unit: 1772

which can be considered the top of the embossment) and adhesively bonded non-embossed sites at 13 (i.e. a valley portion). Refer to figure 3, which is substantially the same as applicant's figure 1A. Refer to column 3, line 70 through column 4, line 2 disclosing that the embossed sites are non-adhesively bonded, even if it is quite low for normal moisture content webs and more adhesion is provided if the moisture content is about 20%. Also refer to column 3, line 26 through column 4, line 36. Donnelly also teaches the embossments are at least 1000 μ m. Refer to column 3, lines 39-45 which disclose the frustum that form the embossment is 0.035-0.050 inches high (i.e. 899 μ m-1270 μ m). Donnelly does fail to specifically disclose the less than 30% adhesive bond area. Donnelly is silent as to the percent coverage, however, does disclose the adhesive is applied in small discrete amounts in order to avoid final product stiffening (column 3, lines 58-60). This examiner believes this implies that the adhesive coverage is of a small amount.

Ruppel et al discloses two sheets 5, 6 that are embossed and adhesively 9 bonded. Refer to figures 1 and 4. The height of the embossments is 1-2mm (i.e. 1000-2000 μ m). The area bonded by the adhesive is disclosed as .1-20% (column 2, lines 19-23).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Donnelly to have the adhesive bond area of less than 30%, as taught by Ruppel, in order to avoid product stiffening and provide a soft feeling tissue therefrom motivated by the fact both references indicate this is a desirable property thereof. With regards to the specific properties of claims 2,3 and 6, which are

Art Unit: 1772

all drawn to strength properties of the product Ruppel et al does disclose that it is known that embossing multiply sheets results in improved liquid absorption, touch and softness. Therefore, it would have been obvious to one having ordinary skill in the art to vary the strength properties of the product as desired for its particular application (i.e. tissue and or toilet paper) in order to form an improved product therefrom. With regards to claim 5, the sheet caliper would be at least 39-79 mils (1000-2000 μ m) since the embossments are of this height in Ruppel (column 2, lines 1-65). With regards to claim 7, the sheet can be in roll form per column 3, lines 44-46 disclosing toilet paper of paper towels in Ruppel. With regards to claim 8, the adhesive is disclosed in dot form (see column 2, lines 13-65 and column 4, lines 17-30 in Ruppel and column 3, lines 58-60 in Donnelly disclosing small discrete amounts). With regards to claim 9, the prior art plies are conventional fibrous plies.

Response to Arguments

11. Applicant's arguments filed in the Appeal Brief have been fully considered but they are not persuasive. The applicant argues that Donnelly fails to disclose "non-adhesively bonded embossed sites" and "adhesively bonded non-embossed sites". The examiner has indicated above which sections in Donnelly equate to the applicant's embossed and non-embossed sites. These recitations are drawn to process limitations which do not structurally distinguish the claimed product from the prior art. The structure implied by the claim recitations of embossed and non-embossed are that of a ply having alternating projections (i.e. peaks) and valleys. The multiply product being adhesively bonded in the valley and non-adhesively bonded at the peaks. The peaks and valleys

Art Unit: 1772

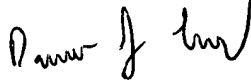
actually have the same structure and just project in opposite directions. One could take a single ply from figure 1 and flip it over and the peak would then be the valley and the valley would then be the peak. This is just a matter of semantics whether one calls it an embossment or non-embossment. One could take either ply 12 or 14 in the applicant's figure 1A and flip it upside down and nest it within the other one and it would be the same structure. One could take the entire figure and flip it over and it would be the same structure. Also, refer applicant's figure 3 showing ply 14 being embossed by protuberances 46 into ply 12 at 16 with no adhesive and ply 12 being embossed by roll 26 into ply 14 at 20, which is where the adhesive is located.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Donald Loney
Primary Examiner
Art Unit 1772

DJL:D.Loney
08/01/06